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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,758	10/14/2003	Masao Teshima	85013-0306201	2031

7590 10/24/2005

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EXAMINER

DATSKOVSKIY, MICHAEL V

ART UNIT PAPER NUMBER

2835

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/684,758	Applicant(s) TESHIMA, MASAO	
	Examiner Michael V. Datskovskiy	Art Unit 2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-47 and 49-52 is/are rejected.
- 7) ☒ Claim(s) 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/14/2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 40, 46-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Masaki

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Masaki (US Patent 6,728,559) teaches an electronic device 20, Figs. 1-10, comprising: a display housing 20a having a display 24 surface and a rear surface opposite to the display surface, the display housing being made of a conductive material (col. 6, line 26), a nonconductive portion being formed in a part of the rear surface (col. 9, lines 53-59); an antenna 1 placed in the nonconductive portion; and a communication unit 60 configured to perform wireless communications by using said antenna 1. Masaki

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teaches furthermore: Said antenna being provided in a central portion in said nonconductive portion in a width direction and in an upper portion in a vertical direction; Said antenna includes an antenna substrate 2a and an antenna element 1 provided on said antenna substrate, wherein said antenna substrate included a printed circuit board formed with a conductive pattern for grounding connected to said conductive housing (Figs. 1-5, col. 6, lines 16-61).

3. Claims 40-43, 45, 47, 49 and 51-52 are also rejected under 35 U.S.C. 102(e) as being anticipated by Amemiya et al (US Patent 6,804,11).

Amemiya et al teach an electronic device 20, Figs. 1-25, comprising: a display housing 3 having a display 31 surface and a rear surface opposite to the display surface, the display housing being made of a conductive material (metallic back panel 3B), a nonconductive portion covered by removable covers 41 and 61 being formed in a part of the rear surface and made of a nonconductive material; an antenna 35 placed in the nonconductive portion; and a communication unit 36 configured to perform wireless communications by using said antenna 35. Amemiya et al teach furthermore: Said electronic device further includes a signal output terminal 35b on signal path between said antenna 35 and said communication unit 36; Said antenna includes an antenna substrate 35c and an antenna element 35a provided on said antenna substrate, wherein said antenna substrate included a printed circuit board formed with a conductive pattern for grounding connected to said conductive housing; and said antenna 35 being provided in an upper portion in said nonconductive portion in a vertical direction facing the nonconductive cover 41 and between said cover 41 and said display 31.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter, as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 44 and 50 are rejected under 35 U.S.C. 103(a) as being obvious over Masaki.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2). Masaki teaches all the limitations of the claims except a perimeter length of said nonconductive portion is equal

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to or longer than one wavelength of a frequency used in wireless communications (claim 44); and a perimeter length of the conductive pattern is in a range of about 0.7 to about 1.4 of a wavelength of a frequency used in wireless communication (claim 50). It would have been obvious to one having ordinary skill in the art at the time invention was made to choose such ranges of these details, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum of workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

6. Claims 44 and 50 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Amemiya et al based on the disclosed above reasons.

Allowable Subject Matter

7. Claim 48 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The electronic device according to claim 40, wherein said antennal projects outward from said housing.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Datskovskiy whose telephone number is (571) 272-2040. The examiner can normally be reached on 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (571) 272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael V Datskovskiy
Primary Examiner
Art Unit 2835

10/20/2005